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EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT PAPER NUMBER

3623

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/522,322

Applicant(s)

FABER ET AL.

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-44, 46-51 and 53-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44, 46-51 and 53-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 7, 2005 has been entered.

Claims 1, 26, 41, 57, and 58 have been amended.

Claim 45 has been cancelled, thereby overcoming the previously pending claim objection.

Claims 1-44, 46-51, and 53-58 are pending.

2. The previously pending rejections under 35 U.S.C. §§ 101 and 112 are withdrawn in response to Applicant's claim amendments.

### ***Response to Arguments***

3. Applicant's arguments filed October 7, 2005 have been fully considered but they are not persuasive.

Applicant argues:

Tagawa does not teach or suggest information that has been recorded on a PC made available from the PC to a plurality of users. The recorded information on the PC of Tagawa is intended to be used only by the user of the PC

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(the digital data recording apparatus). Tagawa discusses the need to protect the copyright of the music data and discloses the decryption and re-encryption process to protect copyright. Thus, it is clear that Tagawa does not teach or suggest "an offer of ***the recorded information*** to a plurality of users". (Page 13 of Applicant's response)

The Examiner respectfully disagrees. As stated in the art rejection, Figs. 6, 8 and ¶¶ 120 and 131 of Tagawa teach that the host computer downloads information to its primary recording medium. Selected information is then downloaded to a user's PC, i.e., the secondary recording medium. ¶ 131 specifically states, "When the data transmit/receive unit **2102** receives the instruction to record the music data, the data transmit/receive unit **2102** downloads the desired music data from the host computer of the respective provider through the telephone line." The end user purchases music from the provider, who stores available music on a provider host computer. The host computer must have had the music recorded on it at some point prior to offering the music to the end user, even if the music is only temporarily stored during the downloading process from the original music source to the end user.

In conclusion, Applicant's arguments are non-persuasive and the art rejection is maintained.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-7, 9-17, 19, 20, 26-30, 33-43, 46-50, and 56-58 are rejected under 35

U.S.C. 102(e) as being anticipated by Tagawa et al. (US 2005/0010795).

Tagawa discloses a system comprising:

[Claim 1] a memory to store a database (Figs. 6, 8; ¶¶ 61, 120, 131 -- The host computer, referred to by Tagawa as belonging to an "information provider," downloads information from the original source of the information, synonymous with the claimed "information provider," to its primary recording medium);

a first logic unit linked with the database to establish a first communications connection with an information provider, the information provider to record information over the first communications connection, the database to store the recorded information (Figs. 6, 8; ¶¶ 61, 120, 131 -- The host computer, referred to by Tagawa as belonging to an "information provider," downloads information from the original source of the information, synonymous with the claimed "information provider," to its primary recording medium);

a second logic unit to provide an offer of the recorded information to a plurality of users (¶¶ 65, 66, 127, 129, 130 -- Users can view and make selections via the Internet);  
and

a third logic unit linked with the database to establish a second communications connection with a user in the plurality of users in response to the user accepting the

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offer and to deliver the recorded information from the database to the user (Figs. 6, 8;

¶¶ 120, 131 -- The host computer downloads information to its primary recording medium. Selected information is then downloaded to a user's PC, i.e., the secondary recording medium);

[Claim 2] wherein the database further stores a description of the information (¶¶ 61, 66, 67, 129);

[Claim 3] a fourth logic unit linked with the database to establish a computer connection with an information provider computer and to receive via the computer connection the description from the information provider (Figs. 6, 8; ¶¶ 61, 65, 70-72, 120, 131);

[Claim 4] wherein the computer connection is established through a web site accessible by the information provider computer (Figs. 6, 8; ¶¶ 61, 65, 66, 120, 127, 129, 131);

[Claim 5] a fourth logic unit linked with the database to establish a computer connection with a user computer and to deliver the description to the user computer via the computer connection (Figs. 6, 8; ¶¶ 61, 65, 66, 70-72, 120, 127, 129, 131);

[Claim 6] wherein the computer connection is established through a web site accessible by the user computer (Figs. 6, 8; ¶¶ 61, 65, 66, 120, 127, 129, 131);

[Claim 7] wherein the description includes a price for the information (¶¶ 67, 70-72, 128);

[Claim 9] wherein the first communications connection includes an audio connection (Figs. 6, 8; ¶¶ 61, 64, 120, 125, 129, 131, 171);

[Claim 10] wherein the first communications connection includes a video connection (Figs. 6, 8; ¶¶ 61, 64, 120, 125, 129, 131, 171);

[Claim 11] wherein the first communications connection is established over a computer network (Figs. 6, 8; ¶¶ 61, 64, 120, 125, 129, 131, 171);

[Claim 12] wherein the first communications connection is established over a telephone network (¶¶ 65, 129, 131);

[Claim 13] wherein the second communications connection includes an audio connection (Figs. 6, 8; ¶¶ 61, 64, 120, 125, 129, 131, 171);

[Claim 14] wherein the second communications connection includes a video connection (Figs. 6, 8; ¶¶ 61, 64, 120, 125, 129, 131, 171);

[Claim 15] wherein the second communications connection is established over a computer network (Figs. 6, 8; ¶¶ 61, 64, 120, 125, 129, 131, 171);

[Claim 16] wherein the second communications is established over a telephone network (¶¶ 65, 124, 129, 131);

[Claim 17] a fourth logic unit to bill the user for the information (Abstract; ¶¶ 16, 24, 69, 72, 90, 101, 103, 116, 123);

[Claim 19] wherein the database further stores information about a user account (Abstract; ¶¶ 16, 24, 69, 72, 90, 101, 103, 116, 123);

[Claim 20] a fourth logic unit to deduct an amount from the user account for the information (Abstract; ¶¶ 16, 24, 69, 72, 90, 101, 103, 116, 123 -- By charging a user, the charged amount is presumably deducted from the user's account).

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[Claims 26-30, 33-40] Claims 26-30 and 33-40 recite limitations already addressed by the rejection of claims 1-7, 9-17, 19, and 20 above; therefore, the same rejection applies.

Furthermore, as per claim 30, Tagawa teaches that the description is included in a list of information providers (Figs. 3, 5, 9).

[Claims 41-43, 46-50, 56] Claims 41-43, 46-50, and 56 recite limitations already addressed by the rejection of claims 1-7, 9-17, 19, and 20 above; therefore, the same rejection applies.

Furthermore, as per claim 43, Tagawa teaches that the description is included in a list of information providers (Figs. 3, 5, 9).

[Claim 57] Claim 57 recites limitations already addressed by the rejection of claims 1-7, 9-17, 19, and 20 above; therefore, the same rejection applies.

[Claim 58] Claim 58 recites limitations already addressed by the rejection of claims 1-7, 9-17, 19, and 20 above; therefore, the same rejection applies.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



7. Claims 31, 32, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa et al. (US 2005/0010795), as applied to claims 30 and 43 above.

[Claims 31, 32] Tagawa does not expressly teach that the list of information providers is delivered to the user in response to a keyword search (claim 31) or in response to a category selection (claim 32). However, Official Notice is taken that it is old and well-known in the art of the selection of information to purchase and download to narrow down desired search results by either utilizing a keyword search or a category selection. Both practices facilitate speedier retrieval of specifically desired information, especially when one must search through a large amount of data. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to enhance Tagawa's invention with the ability to perform keyword searches (claim 31) and category selection (claim 32) to identify sources of desired information in order to facilitate speedier retrieval of specifically desired information, especially when one must search through a large amount of data.

[Claim 44] Claim 44 recites limitations already addressed by the rejection of claim 31 above; therefore, the same rejection applies.

8. Claims 8, 18, 21-25, 51, and 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa et al. (US 2005/0010795), as applied to claims 1, 7, 17, 19, 41, and 50 above, in view of Yokono et al. (US 2002/0029241).

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[Claims 8, 18, 21] Tagawa charges its users for information based on various factors, including a price per information item (Figs. 3, 5), information quality (§ 118), etc.; however, Tagawa does not expressly teach that the price includes a rate per period of time (e.g., how long the information is delivered to the user). Yokono makes up for this deficiency in its teaching of a public downloading apparatus through which a user may download audio or video information, wherein the price of the downloaded information includes a rate per period of time, i.e., the duration of the download at the public downloading apparatus (Fig. 9; §§ 102, 109, 196-198). Yokono essentially implements an information distribution system (including the delivery of audio and video information, § 79), similar to that of Tagawa, at a public downloading apparatus, thereby expanding the access of such a system to a wider range of customers (§ 6) while sufficiently compensating the middleman that connects the original source of information to the customers. Since Yokono improves upon the type of information distribution system taught by Tagawa, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Tagawa to incorporate a price that includes a rate per period of time (claim 8), a fifth logic unit to track how long the information is delivered to the user and the fourth logic unit bills the user based upon how long the information is delivered (claim 18), or a fourth logic unit to track how long the information is delivered to the user and a fifth logic unit to deduct from the user account an amount based upon how long the information is delivered (claim 21) in order to expand the access of Tagawa's system to a wider range of

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customers (§ 6) while sufficiently compensating the middleman that connects the original source of information (i.e., Tagawa's host computer) to the customers.

[Claims 22-25] As discussed in the rejection of claims 8, 18, and 21 above, the Tagawa-Yokono combination addresses the claimed concept of charging a user at the time the information is delivered and based on how long the information is delivered to him/her. However, Tagawa does not expressly teach that the amount owed to the information provider is credited to his/her account. Official Notice is taken that it is old and well-known in the art for an information broker to set up an account for an information provider and then credit the information provider's account accordingly. This allows for quicker reconciliation of charges among the original information provider, information broker, and end customers. Furthermore, while Yokono's fee based on connection time is paid to the middleman between the original information provider and the customer, Yokono does not expressly teach that the amount actually paid to the original information provider is based on this length of connection time. However, the Examiner submits that the connection time is likely based on the size of the transmission. Tagawa states that a higher price may be set for higher quality music (& 118). The provision of higher quality music often requires that the original information source generate information in a higher quality format. Since Tagawa's host computer can charge based on the quality of information and it is old and well-known in the art of communications that higher quality information often requires longer download time to transmit due to increased file size, the Examiner submits that the original source of information would also charge accordingly based on the quality of information provided

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(which commonly affects the download time). Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the Tagawa-Yokono combination to include a fourth logic unit to credit an amount to the account when the information is delivered to the user (claim 23), a fourth logic unit to track how long the information is delivered to the user and a fifth logic unit to credit to the account an amount based upon how long the information is delivered (claims 24, 25), wherein the database further stores information about an account set up for the information provider (claim 22) in order to facilitate quicker reconciliation of charges among the original information provider, information broker, and end customers while more appropriately compensating original information providers for higher quality sources of information, which often require longer download times.

Additionally, as per claim 25, Official Notice is taken that it is old and well-known in the art for an information broker to charge an extra fee to compensate any additional expenses incurred as part of his/her services. Since Tagawa and Yokono discuss information brokerage systems, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to incorporate with the Tagawa-Yokono combination a fourth logic unit to track how long the information is delivered to the user and a fifth logic unit to credit to the account an amount based upon how long the information is delivered minus a fee in order to compensate Tagawa's host computer with any additional expenses incurred as part of his/her services.

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[Claims 51, 53-55] Claims 51 and 53-55 recite limitations already addressed by the rejection of claims 8, 18, and 21-25 above; therefore, the same rejection applies.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Susanna M. Diaz  
Primary Examiner  
Art Unit 3623

October 29, 2005